## REMARKS

This paper is responsive to an Office Action mailed March 22, 2005. Prior to this response claims 1-25 were pending. After amending claims 1, 2, 13, and 14, claims 1-25 remain pending.

In Section 3 of the Office Action, claims 1-2 have been rejected under 35 U.S.C. 102(e) as anticipated by the Mazzagatte et al. ("Mazzagatte"; US 6,862,583). With respect to claim 1, the Office Action states that Mazzagatte describes the selection of a profile with an encryption field (col. 8, ln. 1-27), the scanning of a document (col. 7, ln. 11-15, and the encryption of the document in response to the encryption field of the selected profile (col. 8, ln. 45-55). This rejection is traversed as follows.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Claims 1 and 2 have been amended to more clearly recite that the present invention concerns operations associated with the use of a network-connected scanner. These claims are summarized as follows. The scanner stores profiles. Each profile includes an encryption field, for example, a key. A user submits a document for scanning, selects a profile, and the scanned document is encrypted using the field from the profile.

Mazzagatte describes a process that, in some respects, is almost the reverse of the claimed invention process. Generally, Mazzagatte creates a print job at a sending node, i.e., a desktop computer

sla1086_response 1.doc                    9

10 print driver (col. 7, ln. 46-55). The sending node submits the job to a print node along with unique identification information (col. 8, ln. 19-29). The print node encrypts and stores the print job after it is received (col. 8, ln. 62-67). After the user arrives at the print node and presents their unique user identification information, the print node decrypts the print job and prints it (col. 9, ln. 26-35).

Generally, the claimed invention recites scanning operations, while Mazzagatte describes print job processes. More particularly, Mazzagatte does not describe the selection of a profile with an encryption field, as recited in claim 1. Neither does Mazzagatte describe the use of a scanner user interface to perform any kind of encryption process. Mazzagatte does describe the submission of a physical medium document, and the scanning of this document by a scanner, as recited in claim 1. Further, Mazzagatte does not describe a scanned document being encrypted using the encryption field of the selected profile, as recited in claim 1. With respect to claim 2, Mazzagatte does not describe the transmission of an encrypted scan job.

As noted above, Mazzagatte does not explicitly describe every element of the invention of claim 1. Since Mazzagatte does not describe every limitation of the claimed invention, he cannot anticipate. Claim 2, dependent from claim 1, enjoys the same distinctions from the cited prior art as the independent claim, and the Applicant respectfully requests that the rejection be removed.

In Section 4 of the Office Action, claims 3-25 have been rejected under 35 U.S.C. 103(a) as unpatentable with respect to the Mazzagatte, in view of Weschler, Jr. ("Weschler"; US 6,651,047). With respect to claims 3, 13, and 14, the Office Action acknowledges that

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Mazzagatte fails to describe the storage and selection of profiles from a directory. The Office Action states that Weschler describes directories that are data structures with information such as addresses and public key information (col. 4, ln. 22-26, and col. 5, ln. 13-33). The Office Action states that it would have been obvious to use a directory as taught by Weschler "to store the profiles in order to ensure security when there is a directory to refer for comparison or for authentication purposes" (col. 10, ln. 54-67). This rejection is traversed as follows.

An invention is unpatentable if the differences between it and the prior art would have been obvious at the time of the invention. As stated in MPEP § 2143, there are three requirements to establish a *prima facie* case of obviousness.

> First, there must be some suggestion or
> motivation, either in the references themselves or in the
> knowledge generally available to one of ordinary skill in the
> art, to modify the reference or to combine reference
> teachings. Second, there must be a reasonable expectation of
> success. Finally, the prior art reference (or references when
> combined) must teach or suggest all the claim limitations.
> The teaching or suggestion to make the claimed combination
> and reasonable expectation of success must both be found in
> the prior art and not based on applicant's disclosure. *In re
> Vaeck* 947 F.2d 488, 20 USPQ2d, 1438 (Fed. Cir. 1991).

Generally, Weschler describes a secure data record storage mechanism (Abstract). In his Background Section, Weschler states that directories are problematic method of finding resources in a distributed system, as directories contain duplicate information and are difficult to maintain (col 4, ln. 22-30). At col. 5, ln. 10-35, Weschler describes a prior art Domain Name System (DNS), which uses a Lightweight Directory Access Protocol (LDAC) to make domain name searches. At col. 10, ln. 59-

sla1086_response 1.doc                          11

67, Weschler describes a core profile engine that maintains a set of meta-data about every profile. The meta-data controls how the core profile engine makes profile data available to client applications.

With respect to the *first prima* facie requirement, the issue is not whether it would have been obvious to one skilled in the art to use a directory like Weschler's to ensure security, as stated in the Office Action. Rather, the issue concerns whether there is a motivation to combine a directory like Weschler's, with Mazzagatte's print job system. The issue of motivation does not concern itself with whether it is possible to combine two references. If it did, then almost any two references could be combined to create an obviousness rejection. Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion of motivation in the references to do so." *In re Mills*, 916 F.2d 680, 682, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990). Here, the analysis must determine if there is any motivation to modify Mazzagatte's encrypting/decrypting print node in such a manner as to teach the claimed invention. As noted above in the response to the anticipation rejection, there are several elements recited in the claimed invention that are not described by Mazzagatte. None of these missing limitations are supplied by Weschler. Therefore, even if there is a motivation to combine Weschler and Mazzagatte, that combination does not suggest the claimed invention.

The second *prima facie* requirement addresses the same issue from another point of view. Even if an expert were given the two references are a starting point, there is no reasonable expectation that this expert would come up with the claimed invention. The combination of references does not provide an expectation of success that a scanning

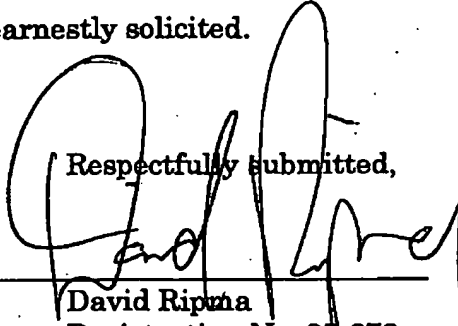sla1086_response 1.doc                    12 .

device can be established with a directory that permits scan jobs to be automatically encrypted in response to selecting a profile.

With respect to the third requirement to support a *prima facie* case of obviousness, the combination of references does not teach all the limitations of claims 1, 13, and 14. Neither Mazzagatte nor Weschler describe scanning processes or scan job. Neither reference describes the selection of profile, with an encryption field, at a scanner user interface. Neither Mazzagatte nor Weschler describe the submission of a physical medium document, the scanning of a document, or the encryption of a scanned document using the encryption field of the selected profile. All the features are recited in claims 1, 13, and 14 of the claimed invention. With respect to claims 13 and 14, neither Mazzagatte nor Weschler describe the transmission of an encrypted document from a scanning device.

In summary, the combination of the Weschler and Mazzagatte does not explicitly describe all the elements of claims 1, 13, and 14. Neither do the references suggest any modifications that make these claims obvious. Claims 3-12, dependent from claim 1, and claims 15-25, dependent from claim 14, enjoy the same distinctions, and the Applicant respectfully requests that the rejection be removed.

sla1086_response 1.doc                13

It is believed that the application is in condition for allowance and reconsideration is earnestly solicited.

Respectfully submitted,

Date: 5/2/05

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sla1086_response 1.doc                    14